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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,396	01/16/2001	William R. Moser	24961-5	4778

7590

10/05/2004

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EXAMINER

NGUYEN, CAM N

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/761,396	Applicant(s) MOSER ET AL.	
	Examiner Cam N Nguyen	Art Unit 1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/16/01 (a CIP of application 09/426,254, now U.S. Pat. 6,365,555)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 9 & 10 are objected to because of the following informalities:
 - A. In claim 9, line 1, "of" should be deleted.
 - B. In claim 10, line 2, "abot" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112 (Second Paragraph)

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Regarding claims 1-6, the claims are called for "a catalyst", but there is no limitation on the catalytic structure for the catalyst being claimed, except for the process limitations. The only catalytic metals claimed is those metals listed in claim 7. Thus, renders the claims vague and indefinite.

B. Regarding claims 8 & 9, recitations of "having the characteristics shown in Fig. 3 of the present invention" and "having the characteristics shown in Fig. 4 of the present invention", respectively, do not particularly point out the properties of the catalysts in the claims itself. Although the claims are interpreted in light of the specification, limitations

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from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

C. Regarding claim 10, line 1, "small grain material" is unclear as to what applicants intend. It might be that applicants intended to recite "small grain particles", but the claim does not particularly point out so.

Claim Rejections - 35 USC § 102(b)/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagase et al., "hereinafter Nagase", (US Pat. 5,395,812).

Nagase discloses a silver catalyst which comprises a α -alumina carrier (see col. 13, claim 1).

Product-by-process limitations in the claims is noted. While the process steps in the claims are not disregarded, they are regarded as process limitations. It is

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considered that since the disclosed catalyst is the same as the claimed catalyst, the claims are anticipated by the reference. It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method or production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even the prior art product was made by a different process." See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP* 2113.

Claim Rejections - 35 USC § 102(b)

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Nagase et al., "hereinafter Nagase", (US Pat. 5,395,812).

Nagase discloses a silver catalyst which comprises a α -alumina carrier (see col. 13, claim 1).

Each and every element of the claim is disclosed by the reference, thus anticipates the claim.

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8. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Langner et al., "hereinafter Langner", (US Pat. 5,817,855).

Langner discloses copper-based catalyst composition (see col. 7, claim 1).

Each and every element of the claim is disclosed by the reference, thus anticipates the claim.

9. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Armor et al., "hereinafter Armor", (US Pat. 4,469,816).

Armor discloses a catalyst composition comprising a uniform dispersion of individual particles of metallic palladium supported on an alumina support (see col. 8, claim 1). The metallic palladium comprises individual particles having diameters in the range of about 0.2 nm to 30 nm (see col. 8, claim 3).

Each and every element of the claim is disclosed by the reference, thus anticipates the claim.

Citations

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form prepared attached. All references are cited for related art.

Conclusion

11. Claims 1-10 are originally pending in the application. Claims 1-10 are rejected.
No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (571) 272-1357. The examiner can normally be reached on M-F from 8:30 am. to 6:00 pm.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to telephone number (571) 272-1700.

Nguyen/cnn *cnn*

September 28, 2004

Cam Nguyen
CAM N. NGUYEN
PRIMARY EXAMINER

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